

Remarks

Applicant has considered the Final Office Action mailed on December 26. Claims 21-31 and 33-40 are pending in the present patent application. Of the pending claims, the Examiner rejected claims 21-31 and 33-40. In response to the Final Office Action, Applicant canceled claim 29 and incorporated subject matter therefrom into claim 21 to distinguish over the combination of references used in the 35 USC §103(a) rejection. In addition, Applicant amended claim 30 with subject matter from claim 33 to overcome the §103(a) rejection. As a result, Applicant amended claim 33 to conform with the changes made to claim 30. In addition, Applicant amended claim 34 similarly to claim 21 to distinguish over the combination of references used in the §103(a) rejection. No new matter has been added. These amendments, which are in compliance with 37 CFR §1.116, materially clarify the issues raised by the Examiner and do not recite differently claimed subject matter which would require a further search by the Examiner. Accordingly, Applicant requests that the Examiner enter the amendments and reconsider the present patent application in light of the above-noted changes and the following comments.

In the Final Office Action the Examiner has maintained the rejection of claims 21-31 and 33-40 under 35 USC §103(a) as being unpatentable over Levin et al. (US Patent No. 6,654,546) in view of Nishio et al. (US Patent No. 6,345,388). As mentioned above, Applicant amended independent claims 21, 30 and 34 to overcome the §103(a) rejection. Applicant submits that claims 21-28,

30-31 and 33-40 are patentable over the combination of Levin et al. (hereinafter Levin) in view of Nishio et al. (hereinafter Nishio).

As amended, claims 21 and 34 each recites *inter alia*, the limitation that the change to software controls a data format of the content for play out. The Examiner submitted that col. 4, line 51 - col. 5, line 42 in Nishio teaches this limitation. Applicant does not concur and submits that the material discussed in this section of Nishio does not teach making a change to software that controls a data format of the content for play out. As mentioned in Applicant's previous response, this section of Nishio relates to providing a user with a specified grade of image quality. In particular, Nishio teaches that a system decoder 10 receives a MPEG2-System stream 100 as input. The system decoder 10 analyzes the MPEG2-System stream 100 and extracts accounting information 102 and a MPEG2-Video stream 103 from the MPEG2-System stream 100. An accounting control unit 12 receives the extracted accounting information 102 and the user requested accounting level 101, and outputs the decoding coefficient control signal 104. A MPEG2-Video decoder 11 receives the MPEG2-Video stream 103 and the decoding coefficient control signal 104 and performs an orthogonal transform on the video stream to generate a video signal output 107 (see FIG. 1 and col. 4, line 28 through col. 5, line 10).

None of these operations performed in Nishio are equivalent to making a change to software that controls a data format of the content for play out as recited in independent claims 21 and 34. Functions such as analyzing the MPEG2-System stream 100, extracting accounting information 102 and the

MPEG2-Video stream 103, outputting the decoding coefficient control signal 104, performing an orthogonal transform on the MPEG2-Video stream 103 and generating the video signal output 107 do not encompass making changes which would entail a change to software that controls a data format of the content for play out as recited in claims 21 and 34. Instead, these operations pertain to providing a user with a specified grade of image quality.

Furthermore, in the Final Office Action, the Examiner explained in the *Response to Arguments* section that:

Nishio explicitly states that the decoding coefficient [104] is varied (and thereby ‘changes’) in accordance with the particular accounting level (Col 5, Lines 29-36). The particular decoding coefficient [104] serves as an instruction that controls and/or alters the particular decoding algorithm in the MPEG decoder [11] or ‘rendering circuit’ in order to generate/render a particular quality of content (Col 5, Lines 3-10)

Thus, the Examiner construes the decoding coefficient [104] as the claimed “software controlling a rendering circuit”. In the columns and lines cited by the Examiner against former claim 29 (col. 4, line 51-col. 5, line 42), decoding coefficient 104 is first mentioned in the following context:

Receiving the decoding coefficient control signal 104, the MPEG2-Video decoder 11 performs decoding (orthogonal transform) of the stream 103 at a level corresponding to the decoding coefficient control signal 104, and outputs a video signal 107. To be specific, the stream 103 is fully decoded when the accounting level is high whereas only a low-frequency component of the stream 103 is decoded when the accounting level is low.

The Examiner is reminded that claim 21 (formerly claim 29), now recites “the change to the software controls a data format of the content information for play out.” There is no mention of any change to the decoding coefficient 104 or the decoding coefficient controlling a data format of the content information. The change of the stream 103 into a video signal 107 is controlled by the MPEG2-Video decoder 11.

Decoding coefficient 104 is only mentioned one other time in the Examiner’s citation in col. 5, lines 29-42):

As described above, according to the first embodiment of the invention, a digitally coded television signal, such as the MPEG2-Video stream 103, is transmitted, and an accounting level requested by the user is input to the receiver as the user input 101, whereby the decoding coefficient (DCT coefficient) at the decoding in the MPEG2-Video decoder 11 is varied to obtain an image having a resolution according to the accounting level. Therefore, an apparatus and a method for transmitting and receiving television signals that can offer a service with a resolution according to the accounting level are realized. In addition, since decoding of the stream 103 is performed by an operation according to the decoding coefficient which can be set ungradedly, it is possible to set the accounting level ungradedly.

Thus, the decoding coefficient is varied to obtain an image having a particular ***image resolution***. An image resolution is not a data format. There is no mention of a change to the software to control a data format of the content information.

Thus, the Office’s citation is entirely conclusory. MPEP guidelines per 1.104(c)(2) of Title 37 of the Code of Federal regulations and section 707 of the MPEP state that “the particular part relied on must be designated” and “the

pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified". The Office has not identified which feature(s) of the Nishio '388 patent are deemed to correspond to the claimed "change to the software controls a data format of the content information". If the Examiner still believes that Nishio discloses a "change to the software controls a data format of the content information," as claimed, then The Examiner is respectfully requested to specifically identify the feature(s) of Nishio '388 that are deemed to be a change to the software controlling a data format of the content information. A vague reference to an entire column in a patent, where most of the column does not even discuss the referenced subject matter does not clearly explain the pertinence of the reference and does not establish a *prima facie* case of unpatentability.

As amended, claim 30 recites *inter alia*, the limitation that the recited specific quality determines a resolution of the rendered content information and a color depth of the rendered content information. The Examiner submitted that col. 5, lines 29-42 in Nishio is the part of the combination that teaches this limitation. Applicant does not concur and submits that the material discussed in this section of Nishio only relates to providing a user with a specified grade of image quality. There are no teachings that color depth is associated with or desired by the specified grade of image quality that a user of Nishio's system receives.

Because the combination of Levin in view of Nishio does not disclose or suggest the limitations of making a change to software that controls a data

format of the content for play out and having color depth as part of the specified grade of image quality, Applicant submits that claims 21, 30 and 34 of the present patent application are patentably distinguishable over the combination of Levin in view of Nishio. Claims 22-28; 31, 33; and 35-40 depend from presumably allowable claims 21, 30 and 34, respectively, and thus Applicant submits that these claims are allowable by dependency. Accordingly, Applicant requests that the Examiner reconsider and remove the §103(a) rejection of claims 21-28, 30-31 and 33-40.

In view of the foregoing amendments and remarks, Applicant requests that the Examiner reconsider this application and allow claims 21-28, 30-31 and 33-40.

If the Examiner has any questions regarding the present patent application, the Examiner can call Applicant's attorney, David C. Goldman, at telephone number (518) 449 0044.

Respectfully submitted,

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